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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,992	12/11/2003	Shyam Kumar Verma	208-6139CT	8307
20995 7590 05/01/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER KHAN, AMINA S	
			ART UNIT	PAPER NUMBER
			1751	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	05/01/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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## Office Action Summary

Application No.

10/732,992

Applicant(s)

VERMA ET AL.

Examiner

Amina Khan

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 43-63 and 73-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-63 and 73-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2007 has been entered.
2. Claims 43-63 and 73-77 are pending. Claims 1-42, 64-72 and 78-92 have been cancelled. Claims 43, 73, 74, 76 and 77 have been amended. Previously cancelled claim 75 has been reinstated.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1751

4. Claims 43-56, 73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verma et al. (WO 97/49842) in view of Chandler et al. (US 5,577,388).

Verma et al. teaches absorption solutions for use in refrigeration systems with corrosion inhibiting effects (abstract) comprising at least one heteropoly complex ion of transition metal element (page 4, lines 1-35). Verma further teaches the claimed heteropoly complex ions (column 3, lines 15-48) of the formulas claimed in claim 46, where X is phosphorous, manganese, tellurium or arsenic (page 8, lines 10-15) and M is molybdenum or tungsten (page 8, lines 18-29). Verma further teaches heteropoly complex anion selected from phosphomolybdates of the formula  $[\text{PMo}_{12}\text{O}_{40}]^{-3}$ , silicon molybdates, silicon tungstates, tellurium molybdates, arsenic molybdates, and mixtures thereof (page 8, lines 30-37; page 9, lines 1-10).

Verma does not teach absorption compositions comprising 20-80 weight percent alkali metal hydroxides, alkaline metal earth hydroxides, or mixtures thereof and additional anticorrosive transition metal compounds.

Chandler et al., in the analogous art of absorption fluids for use in refrigeration systems (column 4, lines 15-20), teaches absorption working fluids comprising between 30-80% alkali metal hydroxides (column 1, line 65 to column 2, line 20), manganese, zinc, and iron chlorides and bromides (column 1, lines 40-60) and corrosion inhibitors such as chromates, tungstates or molybdates (column 4, lines 10-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the absorption fluids taught by Verma et al. by

Art Unit: 1751

incorporating the hydroxides at the claimed percentages, transitional metal halides and other transitional metal corrosion inhibitors as taught by Chandler et al. because Chandler et al. teaches that optimum energy storage potentials of absorption fluids in refrigeration systems are realized when sodium hydroxide and potassium hydroxide are present at these percentages (column 2, lines 1-10). It is prima facie obvious to combine the two compounds, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423 when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. A person of ordinary skill in the absorption refrigeration solution art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results.

The "consisting essentially of" language does not necessarily exclude the additional ingredients of the references because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the additional ingredients of the references materially affect the instant invention.

5. Claims 57-63 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verma et al. (WO 97/49842) in view of Chandler et al. (US 5,577,388) as applied to the claims above, and further in view of Kujak et al. (US 5,783,104).

Verma et al. and Chandler et al. are relied upon as set forth above.

Verma et al. and Chandler et al. do not teach compositions comprising germanium bromides or cobalt chloride.

Kujak et al., in the analogous art of refrigeration absorption solutions, teaches absorption solutions comprising transition metal halides such as cobalt chloride (column 3, lines 14-30) and corrosion inhibitors such as germanium bromide in an amount sufficient to inhibit corrosion (column 3, lines 55-67; column 4, lines 1-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the absorption fluids taught by Verma et al. and Chandler et al. by incorporating transition metal halides such as cobalt chloride as well as germanium bromide as taught by Kujak et al. because Kujak et al. teaches that these compounds inhibit corrosion even when present in low concentrations on the refrigerant solutions (column 3, lines 64-68). It is prima facie obvious to combine the two compounds, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423 when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. A person of ordinary skill in the absorption refrigeration solution art would expect combinations of these

Art Unit: 1751

materials to behave in the same fashion as the individual materials, absent unexpected results.

All disclosures of the prior art, including non-preferred embodiment, must be considered. See *In re Lamberti and Konort*, 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328 (CCPA 9173). Nonpreferred embodiments can be indicative of obviousness, see *Merck & Co. v. Biocraft Laboratories Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1989); *In re Lamberti*, 192 USPQ 278 (CCPA 1976); *In re Kohler*, 177 USPQ 399. A reference is not limited to the working examples, see *In re Fracalossi*, 215 USPQ 569 (CCPA 1982).

The "consisting essentially of" language does not necessarily exclude the additional ingredients of the references because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the additional ingredients of the references materially affect the instant invention.

6. Claims 57-60,62 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verma et al. (WO 97/49842) in view of Chandler et al. (US 5,577,388) as applied to the claims above, and further in view of Takahashi (JP402296888).

Verma et al. and Chandler et al. are relied upon as set forth above.

Verma et al. and Chandler et al. do not teach compositions comprising antimony oxides or cobalt chloride.

Takahashi, in the analogous art of refrigeration absorption solutions, teaches absorption solutions comprising the corrosion inhibitors cobalt chloride and antimony trioxide (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the absorption fluids taught by Verma et al. and Chandler et al. by incorporating transition metal halides such as cobalt chloride as well as antimony trioxide as taught by Takahashi because Takahashi teaches that these compounds have high corrosion inhibiting capabilities when included in absorbent liquids for refrigerating machines (abstract). It is prima facie obvious to combine the compounds, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423 when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. A person of ordinary skill in the absorption refrigeration solution art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results.

The "consisting essentially of" language does not necessarily exclude the additional ingredients of the references because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.*



(Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the additional ingredients of the references materially affect the instant invention.

7. Claims 57-60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verma et al. (WO 97/49842) in view of Chandler et al. (US 5,577,388) as applied to the claims above, and further in view of Yazaki Corp (JP01174588).

Verma et al. and Chandler et al. are relied upon as set forth above.

Verma et al. and Chandler et al. do not teach compositions comprising antimony oxides.

Yazaki Corp, in the analogous art of refrigeration absorption solutions, teaches absorption solutions comprising diantimony trioxide (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the absorption fluids taught by Verma et al. and Chandler et al. by diantimony trioxide as taught by Yazaki Corp because Yazaki Corp teaches that these compounds form dense protective films on the surface of steel and copper and provide improved corrosion controlling effects in refrigeration machines (abstract). It is prima facie obvious to combine the compounds, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423 when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. A person of ordinary skill in the absorption refrigeration solution art would

expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results.

The "consisting essentially of" language does not necessarily exclude the additional ingredients of the references because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the additional ingredients of the references materially affect the instant invention.

8. Claims 57-60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verma et al. (WO 97/49842) in view of Chandler et al. (US 5,577,388) as applied to the claims above, and further in view of Greenley et al. (US 3,200,604).

Verma et al. and Chandler et al. are relied upon as set forth above.

Verma et al. and Chandler et al. do not teach compositions comprising antimony oxides.

Greenley et al., in the analogous art of refrigeration absorption solutions, teaches absorption solutions comprising corrosion inhibitors such as oxides of antimony (page 5, lines 60-75; column 6, Tables I and III; column 8, lines 60-70). Greenley et al. further teaches that the antimonial coatings are corrosion resistant while at the same time have the property of tending to inhibit those metal portions of absorption refrigeration machines which are subject to corrosion by being in contact with absorbent solution. Greenley et al. further teaches these compositions provide superior corrosion resistant

Art Unit: 1751

properties at relatively high temperatures even when substantial oxygen is present in the system to cause oxidation to the metal surfaces (column 9, lines 15-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the absorption fluids taught by Verma et al. and Chandler et al. by incorporating antimony oxides as taught by Greenley et al. because Greenley et al. teaches that these compounds form dense protective films on the surface of steel and copper and provide a marked decrease in corrosion rates in refrigeration machines (column 5, lines 65-76; column 7, lines 60-75). It is prima facie obvious to combine the compounds, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423 when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. A person of ordinary skill in the absorption refrigeration solution art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results.

The "consisting essentially of" language does not necessarily exclude the additional ingredients of the references because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the additional ingredients of the references materially affect the instant invention.

9. Claims 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verma et al. (WO 97/49842) in view of Greenley et al. (US 3,200,604) and further in view of Cheng et al. (US 5,871,667).

Verma et al. and Greenley et al. are relied upon as set forth above.

Verma further teaches absorption solutions comprising lithium hydroxide (page 10, lines 30-35).

Verma et al. and Greenley et al. do not teach compositions comprising antimony tribromide. However, Greenley et al. clearly teaches  $\text{Sb}_2\text{O}_4$  and  $\text{Sb}_2\text{O}_3$ .

Cheng et al. teaches the equivalent anticorrosive properties antimony tribromides and various antimony oxides such as  $\text{Sb}_2\text{O}_4$  and  $\text{Sb}_2\text{O}_3$  (page 5, 1-30). Cheng et al. further teaches that these compositions are highly effective in inhibiting corrosion of ferrous metals such as steel (column 1, lines 50-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the absorption fluids taught by Verma et al. and Greenley et al. by substituting antimony tribromides for antimony oxides as taught by Cheng et al. because Cheng et al. teaches the equivalence of antimony tribromides and antimony oxides in effectively inhibiting corrosion of metals such as steel a common component of refrigeration systems. The substitution of art recognized equivalents only involves routine skill in the art. A person of ordinary skill in the absorption refrigeration solution art would have been motivated to combine the references absent unexpected results.

The "consisting essentially of" language does not necessarily exclude the additional ingredients of the references because "consisting essentially of" renders the

Art Unit: 1751

composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the additional ingredients of the references materially affect the instant invention.

### ***Response to Arguments***

10. Applicant's arguments filed regarding the Verma, Chandler, Kujak, Takahashi, Yakaki Corp., Greenley and Chang references have been fully considered but they are not persuasive.

The applicant argues:

"Applicants' amended generic claims recite the absorbent as consisting essentially of at least one alkaline metal hydroxide, alkaline earth metal hydroxide or mixtures thereof, and thereby exclude substantial amounts of other absorbents, such as an alkali metal halide present in substantial amounts in all compositions disclosed in the primary reference Verma et al. (WO 97/49842). Claims 43-56 and 73 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Verma et al. in view of Chandler et al. The Examiner seeks to modify compositions of Verma et al. to include the amounts of alkaline metal hydroxide and other materials disclosed in Chandler et al. In the final rejection of February 15, 2007, the Examiner specifically states that the rejection is based on the combination of the Verma et al. and Chandler et al. to yield a third composition which contains absorbents of both references. However, the amended claims herewith do not include substantial amounts of other absorbents in view of the language of the claims reciting absorbents as consisting essentially of the hydroxides or mixtures of hydroxides. The combination of Chandler et al. and Verma et al. to arrive at a third composition containing the compositions of those references necessarily including substantial amounts of alkali metal halides does not meet the compositions recited in Applicants' claims. Accordingly, the rejection is improper and cannot be maintained."

The examiner respectfully disagrees. The examiner argues that "consisting essentially of" language does not necessarily exclude the additional materials and absorbents of the references because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially

Art Unit: 1751

affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the additional materials and absorbents of the references materially affect the instant invention.

The rejections over the claims are maintained.


### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1751

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AK  
April 24, 2007

  
**LORNA M. DOUYON**  
**PRIMARY EXAMINER**